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09/735,002

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Michael D. Bullock

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10/31/2007

THE LAW OFFICES OF KENNETH W. FLOAT
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BRASELTON, GA 30517

EXAMINER

DUONG, THANH P

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/735,002
Filing Date: December 12, 2000
Appellant(s): BULLOCK ET AL.

Kenneth W. Float
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the appeal brief filed January 25, 2006 appealing from the Office action mailed November 24, 2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|-----------|-----------------|---------|
| D226,526 | Cicero | 03-1973 |
| D282,952 | Mattingly | 03-1986 |
| 5,769,737 | Holladay et al. | 06-1988 |

D234,962

Swash

04-1975

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Cicero (D226,526). Cicero discloses a putter head (Fig. 1) comprising: a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending “substantially” the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cicero (D226,526). Cicero discloses a putter head (Fig. 1) comprising: a single, solid, unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface extending "substantially" the full height of the body that comprises a sweet spot of the putter head that is about 5/8 to 1/2 inches in width and lateral portions that taper rearwardly away from the ball contact surface. Cicero shows a hole in the upper end (Fig. 1) to receive the shaft member but fails to show a shaft having a grip disposed at an upper end. However, it is conventional and well-known in the golf manufactures to provide a shaft having a grip disposed on the upper end of the of the putter head body and it would have obvious to do so here to provide a hand-engaging means between the user and the putter head.

3. Claims 1-7, 9-15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattingly (D282,952) in view of Holliday '737 and Swash '962. Regarding claims 1-2, 4-5, 7, 9-10, 12-13, 15, and 17, Mattingly '952 discloses a putter head comprising: a single, solid, a trapezoidal unitary body having a front surface with a relatively small, centrally-located, flat ball contact surface that extends the full height of the body and that comprises a sweet spot of the putter head and lateral portions that taper rearwardly away from the ball contact surface a base extending toward a rear end

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of the body. Mattingly shows a cavity on the upper surface to accommodate a shaft but does not show a straight shaft having a grip on Figure 2; however, it is conventional and well-known in the golf manufactures to provide a straight shaft having a grip mounted to the golf club head and it would have been obvious to do so here to provide a hand-engaging means for the putter head. Mattingly does not show a cavity formed behind the ball contact surface and lateral portions and above the base. Mattingly does not disclose a rear portion of the putter head has a cavity. Holliday '737 teaches the large surface cavity 17 removes unnecessary weight from the club head 10 to reduce weight of the putter head (Col. 3, lines 44-50). Swash '962 also teaches rear portion having a cavity to reduce the overall weight of the putter head. Thus, it would have been obvious in view of Holliday and/or Swash to one having ordinary skill in the art to provide a rear cavity as taught by Swash and/or Holliday in order to reduce the overall weight of the putter head. Regarding claims 3 and 11, it is conventional to provide an offset to a shaft member and it would have been obvious to do so here to facilitate alignment of the putter head with the golf ball. Regarding claim 6 and 14, Mattingly shows the lateral portions having flat surfaces; however, it would have been obvious in view of Mattingly to one having ordinary skill in the art the ball will be diverted laterally whether the lateral portions have a curved or flat surfaces (USPN 5,135,228) also show the curved surfaces which provides the same concept of diverting the ball away from the intended target.

(10) Response to Argument

In summary, the claimed invention is directed to a practice putter having a front surface (striking face) with a relatively small, centrally-located, and flat ball contact surface. It is desirable for the user to strike the golf ball against the front surface of the putter head to provide a ball traveling at a straight path or intended target and a ball that is struck at the tapered lateral portions will result a ball traveling at an angle or unintended target. The cited prior art and the applied references disclose a plurality of practice putters with small striking face and such putters are well-known in the art. Applicants attempt to argue that the applied references fail to disclose a putter with the features of the claimed invention but provide no explanation in the original specification if the difference in structure, if any by design choice, provide a putter with unexpected results in term of performance.

In response to Applicants' argument with respect to claim 19, Applicants argue the Cicero '526 reference fail to disclose the front surface of the putter head does not "taper rearwardly away from the contact surface" as on page 3 of the Appeal Brief. Examiner respectfully disagrees. Cicero '526 clearly shows a flat front surface with lateral portions that are taper rearwardly away from the ball contact surface (Figure 1).

In response to Applicants' argument with respect to claim 18, claim 18 recites similar features as in claim 19 and further recites the dimension of the contact surface with a sweet spot of about 5/8 to 1/2 inches and a shaft having a grip disposed at an

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upper end. Cicero discloses a relatively small contact surface with a dimension of about 5/8 to 1/2 inches and shows a hole in the top portion (Figure 1), which inherently provide a means for receiving a shaft member. Cicero does not show a shaft having a grip in the upper portion but Examiner takes Office Notice that it is conventional for golf club manufacturers to provide a shaft having a grip at the upper end and it would have been obvious to do so here to provide a hand-engaging means between the user and the putter head.

With respect to claims 1-7, 9-15, and 17, Applicant argues (on page 5) that *"It is respectfully submitted that neither the Swash design patent nor the Holladay et al. patent discloses or suggests a putter head having a relatively small, centrally-located, flat ball contact surface that comprises a sweet spot of the putter head, or lateral portions that taper rearwardly away from the ball contact surface. Both the Swash design patent and Holladay et al. patent disclose putters that are intended for use in a round of golf, and not practice putters."*

Examiner respectfully disagrees. The applied references discloses the putter head with the features of the claimed invention. The "intended use" in an apparatus claim does not impart structural limitation to the claimed invention. Note, the apparatus must be distinguished from the prior art in terms of structure rather function. See *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1977).

Applicants also argue that *"It is respectfully submitted that one skilled in the art would not modify the Mattingly putter to add a cavity as recited in Claim 1, for example, and certainly not without using hindsight reconstruction. The Mattingly putter head does not have a cavity, and there is no disclosure or suggestion in the Mattingly design patent that it would be desirable to have one. It is respectfully submitted that any modification of the Mattingly putter head to*

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include a cavity is based upon the use of hindsight reconstruction." Examiner respectfully disagrees. Note, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants also argue on page 6 that the modification of Mattingly with Holladay cavity would distort the teachings of the Mattingly putter head. Examiner respectfully disagrees. There is no suggestion that the Design patent of Mattingly provide an alignment feature or as an ornamental feature. It is submitted that the modification of Mattingly with the cavity of Holladay simply reduces the weight of the putter head.

(11) Related Proceeding(s) Appendix

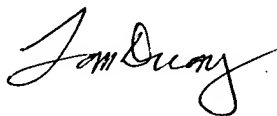
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Tom Duong

October 16, 2007

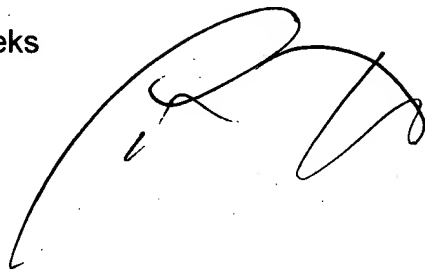


Conferees:

Glenn Caldarola

A handwritten signature in black ink, appearing to be 'Glenn Caldarola', written in a cursive style.

Tim Meeks

A handwritten signature in black ink, appearing to be 'Tim Meeks', written in a cursive style.